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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/483,277 01/13/00 KATZ

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022249
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LMC1/0811

EXAMINER

WOO, S

ART UNIT

PAPER NUMBER

2743

DATE MAILED:

08/11/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/483,277

Applicant(s)
Katz

Examiner
Stella Woo

Group Art Unit
2743



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 22-46 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 22-46 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 22, 24-25, 27-28, 35, 40, 44-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Szlam et al. (USPN 4,797,911, hereinafter "Szlam").

Regarding claims 22, 25, 27-28, 35, Szlam discloses a voice-data control system comprising:

receiving means (ANI decoder 10a24; Fig. 5; col. 12, lines 29-39);

cue means (message player 10a9; col. 12, lines 22-28; col. 13, lines 2-22);

status means (trunk interface control unit 10a13; col. 14, lines 3-43) to selectively indicate responsive signals (via voice recognition module 10a32; col. 13, line 54 - col. 14, line 32) and caller number identification signals (via ANI decoder 10a24; col. 12, lines 35-39) wherein at least one of said responsive signals or at least a portion of said caller number identification signals can be seen as a digital control signal (controls subsequent operation, e.g. uploading customer information, opening new accounts, play next message, cancel/change orders (col. 12, lines 29-54; col. 13, lines 6-18), disconnect trunk, connect to available operator (col. 14, lines 13-18), a digital data signal (account information; col. 13, lines 30-33; col. 14, lines 22-32), or both (caller

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number, DTMF or voice signal acts as a digital control signal which causes subsequent system operation and as a digital data signal as account information);

test means (calling telephone number data is tested to determine whether the caller is an existing client who can then place, change, or cancel orders without the use of an operator; col. 12, line 29 - col. 14, line 32);

control means (system controller 11);

means for storing audio signals (message recorder; col. 17, lines 27-46).

Regarding claims 24, 40, 44-46, Szlam discloses a voice-data control system comprising:

cue means (message player 10a9);

status means (trunk interface control unit 10a13);

memory means (mainframe 16);

means for addressing (data controller 15);

control means (system controller 11);

means for storing audio signals (message recorder; col. 17, lines 27-46);

interface processor (mainframe computer 16 which isolates callers with existing accounts; col. 12, lines 22-66).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 23, 26, 29, 31-34, 36-39, 41, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Szlam in view of Masson et al. (USPN 4,908,850, hereinafter "Masson").

Szlam discloses a voice-data control system comprising:

cue means (message player 10a9);

status means (trunk interface control unit 10a13);

memory means (mainframe 16);

means for addressing (data controller 15; col. 12, line 22 - col. 13, line 42);

control means (system controller 11).

Szlam differs from claims 23, 26, 29, 31, 33-34, and 41 in that although it provides for storing audio signals (col. 17, lines 27-46), it does not specify reproducing caller audio data. However, Masson teaches the desirability of reproducing stored caller audio in order to, for instance, verify shipping address (col. 3, line 60 - col. 4, line 8; col. 6, lines 22-24; col. 7, line 63 - col. 8, line 15; col. 9, lines 25-42). It would have been obvious to an artisan of ordinary skill at the time of invention to incorporate such reproducing of stored caller audio data, as taught by Masson, within the ordering system of Szlam for the same purpose of allowing verification of previously stored audio data, such as shipping address.

Szlam differs from claims 32, 36-39, and 43 in that it does not provide for testing for the presence of stored audio signals. However, Masson provides for testing for the presence of audio signals since different prompts are given to callers depending upon whether or not the audio

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signals representing the shipping address have been stored (col. 7, line 45 - col. 8, line 15) such that it would have been obvious to an artisan of ordinary skill to incorporate such testing for stored audio signals, as taught by Masson, within the ordering system of Szlam in order to determine whether or not to prompt for audio signals. Masson also provides for generating and storing an acknowledgment number (purchase order number) and flags the presence of stored audio signals via a dropship flag (col. 7, lines 55-56; col. 8, lines 23-24).

5. Claims 30 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Szlam in view of Masson, as applied to claims above, and further in view of Barger Jr. et al.

(USPN 4,071,698, hereinafter "Barger").

The combination of Szlam and Masson differs from the claims in that it does not specify testing for use limit. However, as taught by Barger (col. 11, lines 34-47), it is well known in the art to test caller data for limiting the number of uses by the caller such that it would have been obvious to an artisan of ordinary skill to modify the combination of Szlam and Masson by incorporating the use of such testing of call data signals in order to allow for the limiting of the number of system uses by callers.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 22-46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12, 14, 16, 18 of U.S. Patent No. 4,845,739.

Although the conflicting claims are not identical, they are not patentably distinct from each other because differences include merely changes in wording (e.g. voice generator means vs. cue means, record means vs. means for storing).

8. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

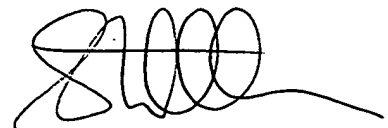
or faxed to:

(703) 308-6306 and (703) 308-6296.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella Woo whose telephone number is (703) 305-4395 and can normally be reached from 6:30 a.m. until 3:00 p.m. on Monday and Tuesday.

August 10, 2000



**STELLA WOO
PRIMARY EXAMINER**